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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,460	11/30/2001	Carol Ivash Gabele	AUS920000652US1	6142
28722	7590	05/09/2006	EXAMINER	
BRACEWELL & PATTERSON, L.L.P.			SILVER, DAVID	
P.O. BOX 969			ART UNIT	
AUSTIN, TX 78767-0969			PAPER NUMBER	
			2128	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/997,460	Applicant(s) GABELE ET AL.	
	Examiner David Silver	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>Nov 9 05, Jan 27 05, 11/30/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are pending in Instant Application.

Information Disclosure Statement

2. The information disclosure statement(s) (IDS) submitted on 11/9/05, 6/27/05, 11/30/01 is/are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement(s) is/are being considered by the examiner.

Specification

3. The disclosure is objected to because of the following informalities: paragraph 361 the word "computer" is misspelled as "comptutor".

Appropriate correction is required.

Claim Interpretation

4. The mere ability or enablement to perform a function does not necessitate the performance of such function. As such, any prior art not explicitly prohibiting the performance of a function inherently allows for the performance of such function and therefore reads on the limitation.

Claim Interpretation – 112 6th Paragraph

5. Claims 6, 7, 10, 11, 12, and 15 are not invoking 35 U.S.C. 112 sixth paragraph for the below emphasized reason:

MPEP 2181 Identifying a 35 U.S.C. - 2100 Patentability recites:

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for" or "step for;"

(B) the "means for" or "step for" must be modified by functional language; and

(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

6. In view of MPEP 2181 (prong (C)), although the claims recite "means for" it is determined and will be interpreted that the details following the "for" refers to intended use and does not invoke 35 USC 112 sixth paragraph.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new

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and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In this instance, absent an explicit and deliberate definition in the specification that the product includes an appropriate medium, the claims are directed to software *per se*. The claims do not produce a useful, tangible, and concrete result. They merely recite carrying out a software algorithm, which, for example, does not display, store, or otherwise provide a useful tangible output. Additionally, software, *per se*, is not considered concrete under the above-recited MPEP citation (MPEP 2106).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claims 1, 6, and 11 use the term "counter event", which has the following definition in the Specification (**paragraph 116**): "A count event is a sequence of signal values that indicate the occurrence of an event within a simulation model for which it would be *advantageous* to maintain a count." The term advantageous is a relative term which renders the claim indefinite. The term "advantageous" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
9. The above cited rejections are merely exemplary. The Applicant(s) are respectfully requested to correct all similar errors.
10. Claims not specifically mentioned are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under

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this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 5, 6, 10, 11, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Son (**US Patent 5,850,345**).

As per claim 1, Son discloses: A method for providing centralized access to count event information from testing of a hardware simulation model within a batch simulation farm of simulation clients and an instrumentation server (**Fig 1, col: 7 line: 19-34 instrumentation server ... supervisor, clients ... simulation devices**), said method comprising:

receiving count event data for said hardware simulation model within said instrumentation server from one or more simulation clients (**col: 8 line: 60-62 discloses communication, Fig 1 "communication port", count event ... col: 8 line: 23-31, communication ... col: 8 line: 32-46**);

generating a first and a second counter report for said hardware simulation model, wherein said first and second counter reports are derived from said count event data received by said instrumentation server (**Fig 3, col: 10 line: 45-59 counter reports ... index pointer; delta.T; time T; time t**);

comparing said first counter report to said second counter report (**col: 10 line: 59-64, col: 10 line: 65 to col: 11 line: 5 T to t, Fig 6 items S2 and S3**); and

responsive to said comparison, generating a counter difference report within said instrumentation server that conveys count event trends associated with said simulation model under different simulation testcases (**col: 9 line: 44-60 trend ... time width and difference between T and t (delta T = T – t); Son's invention provides multiple simulations therefore where each simulation client is simulating its own content and therefore a different simulation testcase compared with other clients., multiple testcases ... next simulation on col: 1 line: 60-66**).

As per claim 5, Son discloses: The method of claim 1, wherein

said first and second counter reports each include a simulator cycle count field that indicates the

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number of simulator cycles over which count event data is recorded during testcase execution on said hardware simulation model (**Fig 1 "simulation time"**),

said comparing said first counter report to said second counter report further comprising computing a count normalization factor between count event data contained within said first and second counter reports utilizing the simulator cycle count field values contained in said first and second counter reports (**Fig 7**).

As per claim(s) 6, 10, 11, and 15, note the rejection of claim(s) 1 and 5 above. The Instant Claim(s) is/are functionally equivalent to the above-rejected claim(s) and is/are therefore rejected under same prior-art teachings.

12. Claims 1, 6, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bargh (**US Patent 6,470,478**).

As per claim 1, Bargh discloses: A method for providing centralized access to count event information from testing of a hardware simulation model within a batch simulation farm of simulation clients and an instrumentation server (**()**), said method comprising:

receiving count event data for said hardware simulation model within said instrumentation server from one or more simulation clients (**()**);

generating a first and a second counter report for said hardware simulation model, wherein said first and second counter reports are derived from said count event data received by said instrumentation server (**()**);

comparing said first counter report to said second counter report (**()**); and responsive to said comparison, generating a counter difference report within said instrumentation server that conveys count event trends associated with said simulation model under different simulation testcases (**()**).

As per claim(s) 6 and 11, note the rejection of claim(s) 1 above. The Instant Claim(s) is/are functionally equivalent to the above-rejected claim(s) and is/are therefore rejected under same prior-art teachings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 2-4, 7-9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son (**US Patent 5,850,345**) as applied to claim 1 above, and further in view of taken Official Notice.

As per claim 2, Son discloses all limitations of claim 1. Son further discloses executing a testcase with respect to said hardware simulation model within said one or more simulation clients (**Fig 1, col: 3 line: 8-14, col: 9 line: 13-22, col: 7 line: 19-34 instrumentation server ... supervisor, clients ... simulation devices**); receiving an aggregate count event packet from said one or more simulation clients, wherein said aggregate count event packet includes count event data recorded during said testcase (**col: 8 line: 31-35 TCP/IP communicates through packets**). Son further discloses storing the count even data (**storing ... col: 9 line: 3-6; col: 7 line: 49-59 "warehouse" analogy serves as a storage**). Son however does not explicitly disclose storing in files. Official Notice is taken with respect to this limitation. It would have been obvious to one of ordinary skill in the art <distributed simulation / computing / simulating> at the time of Applicant's invention to combine the references in order to store the data in files for later retrieval. Thereby saving the time required to re-run the

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simulation in the event of a system error or power failure.

As per claim 3, Son discloses: The method of claim 2, wherein said first and second counter reports are generated in response to user queries processed with respect to said count data storage files **(Fig 1 input means / display means; Furthermore, this feature is inherent in Son. Specifically, the simulation is occurring as a result of a user action (query). The reports are therefore generated in response to a user query.)**.

As per claim 4, Son discloses: The method of claim 2, wherein said first and second counter reports are converted directly from said counter data storage files **(col: 10 line: 59-64, col: 10 line: 65 to col: 11 line: 5 T to t, Fig 6 items S2 and S3)**.

As per claim(s) 7-9 and 12-14, note the rejection of claim(s) 2-4 above. The Instant Claim(s) is/are functionally equivalent to the above-rejected claim(s) and is/are therefore rejected under same prior-art teachings.

Conclusion

14. All claims are rejected.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Silver whose telephone number is (571) 272-8634. The examiner can normally be reached on Monday thru Friday, 10am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/ds/

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